REMARKS

Claims 1, 2, 7-16, 21-35, 40-48, and 54-61 are pending in the present application. By this Response, claims 1, 15, 29, 34, and 48 have been amended and claims 3-6, 17-20, 36-39, and 50-53 have been canceled. Claims 1, 15, 34, and 48 have been amended to incorporate the subject matter previously presented in claims 3-6, 17-20, 36-39, and 50-53. Claim 29 is amended to incorporate subject matter similar to that presented in claims 2, 16, 35, and 49. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

I. 35 U.S.C. § 102, Alleged Anticipation

The Office Action rejects claims 1-61 under 35 U.S.C. § 102(b) as being anticipated by Cole et al. (U.S. Patent No. 5,752,042). This rejection is respectfully traversed.

> As to claims 1, 7, 15, 21, 29, 34, 40, 48 and 54, the Office Action states:
> As per claim 1, Cole discloses **a method for automatically downloading and installing software to a computer system**, (col. 1:9-10, "The invention relates generally to computer networks and deals more particularly with a technique for selecting code updates (i.e. software) stored in a server for installation in a client"), **comprising the steps of:**
> **- receiving an instruction to install an item of software on the computer system** (col. 1:60-61), "A user at the client computer selects from the list and sends the selections (i.e. instruction) to the server computer"),
> **- collecting data about the computer system to form collected data** (col. 1:53, "determine whether the client computer has a version other than a current version of the identified updates (i.e. collected data)"),
> **- based on the collected data, downloading a proper version of the item of software from a server** (col. 1:52-59), "recognizer programs which execute in the client computer to determine whether the client computer has a version other than a current version of the identified code updates. The client sends the results to the server computer which generates a list of code updates which are consistent with the basic system characteristics representing programs that exist on the client computer for which an update would be appropriate"),
> **- installing the proper version based on the collected data, setting configuration options associated with the proper version** (col. 1:62-65, "In response, the server computer addresses of the selected code

updates to the client computer and the client computer downloads (and installs) the selected code updates from a server computer").

Office Action dated February 9, 2005, pages 2-3.

Claim 1, which is representative of the other rejected independent claims 15, 34 and 48 with regard to similarly recited subject matter, reads as follows:

> 1. A method in a server for automatically downloading and installing software to a client computer system, comprising the steps of:
> receiving an instruction from a client computer identifying an item of software to install on the client computer system, wherein the receiving an instruction from the client computer identifying the item of software to install includes a step of receiving the instruction via one of a wireless network, a local area network, an Internet, an intranet, or a wide area network;
> collecting data about the client computer system to form collected data;
> analyzing the collected data to determine a proper version and configuration options;
> receiving the analysis of the collected data, wherein the analysis specifies the proper version and the configuration options;
> based on the collected data and the analysis, determining whether the identified item of software can be installed on and executed by the client computer system in response to receiving the instruction from the client computer identifying the item of software to install on the client computer system;
> if the identified item of software can be installed on and executed by the client computer system, based on the collected data and the analysis, downloading the proper version of the identified item of software from the server;
> installing the proper version;
> based on the collected data and the analysis, setting configuration options associated with the proper version; and
> returning a confirmatory message.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re bond*, 910 F .2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. Kalman v.

Kimberly-Clark Corp., 713 F .2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Cole does not teach every element of the claimed invention arranged as they are in the claims. Specifically, Cole does not teach determining whether the identified item of software can be installed on and executed by the client computer system in response to receiving the instruction from the client computer identifying the item of software to install on the client computer system based on the collected data and the analysis.

Cole is directed to a system where a server computer selects code updates to download to a client computer. The server computer identifies code updates which are consistent with basic system characteristics of the client computer. Then, the server computer sends to the client computer one or more "recognizer" programs or one or more addresses outside of the client computer of the one or more recognizer programs which execute in the client computer to determine whether the client computer has a version other than a current version of the identified code updates. The client sends the results to the server computer which generates a list of code updates which are consistent with the basic system characteristics, representing programs that exist on the client computer for which an update would be appropriate. Next, the server computer sends the list or information about the list to the client computer. A user at the client computer selects from the list and sends the selections to the server computer. In response, the server computer sends addresses of the selected code updates to the client computer and the client computer downloads the selected code updates from a content server.

Thus, with the system of Cole, only a list of code updates that have been determined as being capable of being installed on the client computer are sent to the client for the user of the client to select from. Then, once the user selects a code update to be installed, then the server sends addresses of the selected code updates to the client computer. Cole does not teach determining whether the identified item of software can be installed on and executed by the client computer system in response to receiving the instruction from the client computer identifying the item of software to install on the client computer system. That is, Cole only sends code updates that are capable of being installed on the client device to the client which are consistent with the basic client system characteristics. Therefore, there is no need for the system of Cole to determine if

the user selected code updates cannot be installed. The Office Action alleges that Cole teaches this feature at column 1, lines 52-59, which reads as follows:

> The invention resides in server and client computers for selecting code updates to download to the client computer. The server computer identifies code updates which are consistent with basic system characteristics of the client computer. Then, the server computer sends to the client computer one or more "recognizer" programs or one or more addresses outside of the client computer of the one or more recognizer programs which execute in the client computer to determine whether the client computer has a version other than a current version of the identified code updates. The client sends the results to the server computer which generates a list of code updates which are consistent with the basic system characteristics representing programs that exist on the client computer for which an update would be appropriate. Next, the server computer sends the list or information about the list to the client computer. A user at the client computer selects from the list and sends the selections to the server computer. In response, the server computer sends addresses of the selected code updates to the client computer and the client computer downloads the selected code updates from a server computer.

In this section, while the recognizer program may determine whether the client computer has a version other than a current version of the identified code updates, the user has yet to select which updates the he or she wants applied. Thus, there would be no determination if the item of software, which is selected by the user, cannot be installed on and executed on the computer system and then ending execution of the method. Applicants respectfully point out that the present invention receives an instruction from a client computer to install an item of software on a computer system as the initial step in the method for automatically downloading and installing an item of software on the computer system.

Independent claims 7, 21, 29, 40, and 54 recite similar features in their respective claim terminology. For example, claim 7, which is representative of the other rejected independent claims 21, 40, and 54 with regard so similarly recited subject matter, recites "receiving an instruction from a user input at a client computer to install an item of software on the at least one computer system ... determining whether the item of software (requested by the user) can be installed on and executed by the computer system." Claim 29 recites "wherein the client computer submits a request to the server ... responsive to receiving the request the server schedules an appropriate time to install

an item of software ... make a determination if and how the item of software can be installed and configured."

Thus, Cole does not teach all of the features in independent claims 1, 7, 15, 21, 29, 34, 40, 48, and 54 as is required under 35 U.S.C. § 102. At least by virtue of their dependency on independent claims 1, 7, 15, 21, 29, 34, 40, 48, and 54, the specific features of claims 2, 8-14, 16, 22-28, 30-33, 35, 41-47, 49, and 55-61 are not taught by Cole. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 2, 7-16, 21-35, 40-48, and 54-61 under 35 U.S.C. § 102.

II. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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